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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,353	02/10/2004	Phillip Frederick	10557/293163	1160
30559 7590 08/21/2008 CHIEF PATENT COUNSEL SMITH & NEPHEW, INC. 1450 BROOKS ROAD MEMPHIS, TN 38116				
EXAMINER				
SWIGER III, JAMES L				
ART UNIT		PAPER NUMBER		
3733				
MAIL DATE		DELIVERY MODE		
08/21/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/775,353

**Applicant(s)**

FREDERICK ET AL.

**Examiner**

JAMES L. SWIGER III

**Art Unit**

3733

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 and 25-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 25-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 6/18/2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

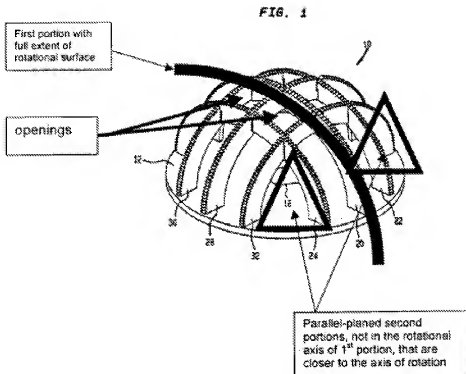
- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8, 9, 25, 27, 29, 32 and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Frieze et al. (US 5,775,719). Frieze et al. disclose a reamer having a hollow body having a "general dome shape" (10) forming an inner and outer surface, and is capable of rotating on an axis (16). The device also has a plurality of raised edges for cutting bone (42) or cartilage, and a plurality of openings for the passing the fragments into the interior portion of the reamer (see drawing below). Also shown below is the reamer disclosed by Frieze et al. having a first portion dimensioned as a surface of rotation, and a second portion not forming a surface of rotation that is generally located closer to the axis of rotation than the first portion. For clarification, the triangular sections represent a portion of the reamer head that may be considered a second portion, separate from the shown first "banded" and rotational portion. These two portions are closer to the location of the axis of rotation (16), than from the extents of the first portion as a rotational surface. These portions also show at least *one* side. Though difficult to show, the two triangles are in planes substantially parallel.



Further, with regards to claims 8 and 12, the device of Frieze et al. is capable of use in surgery for either hip replacement or in the acetabulum of an animal or a human.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10-12, 31 and 34 rejected under 35 U.S.C. 103(a) as being unpatentable over Frieze et al. (US 5,775,719) in view Desarzens et al. (US Pub 2006/0129157). Frieze et al. disclose the claimed invention except for cutting edges straddling a middle portion of a hollow body. Desarzens et al. disclose cutting edges straddling a middle

portion in Fig. 4. This allows for optimal cutting and still having a reduced profile (see par 0019). It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Frieze et al. with at least cutting edges confined to the middle portion in view of Desarzens et al. to have an optimal cutting surface that further has a low profile.

Claims 26, 28, 30, 33 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frieze et al. (US 5,775,719) in view of Brown (US Patent 4,712,951). Frieze et al. disclose the claimed invention except for substantially enclosed dome sides. Brown shows and discloses substantially enclosed dome sides (see Fig. 10, 52). This reduced profile, see also (Col. 4, lines 35-50) helps the device to be inserted into the target area and reduce trauma, which is also known in the art. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Frieze et al. having at least substantially enclosed sides as part of the dome in view of Brown to have a smaller cutting surface and improved insertion capabilities to reduce patient trauma.

#### ***Response to Arguments***

Examiner notes to applicant that it is unnecessary that new claims be completely underlined as submitted on 4/14/2008.

Applicant's arguments, see response, filed 4/14/2008, with respect to the Lechot reference have been fully considered and are persuasive. The rejections with regards to Lechot have been withdrawn.

It is further noted, however, that applicant's arguments submitted 4/14/2008 with

regards to claims 1-12 and 25-36 in regards to Frieze et al. have been considered but are not persuasive. It is held that at least Frieze et al. discloses a hollow domed surface with at least one side. With regard to that one side "reducing a dimension" it is noted that that portion shown by the triangle above is at least 'a dimension' of the dome, and thus reads on the claimed apparatus. This side is further parallel to a rotational axis and is not on a rotational side.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES L. SWIGER III whose telephone number is

(571)272-5557. The examiner can normally be reached on Monday through Friday, 9:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JAMES L SWIGER/  
Examiner, Art Unit 3733

/Eduardo C. Robert/  
Supervisory Patent Examiner, Art Unit 3733